## REMARKS/ARGUMENTS

The claims are not amended in this paper.

## Related Art Rejections

1. The rejection of claims 1-4, 6, 9, 10, 19 and 20 under 35 USC § 103(a) in view of US 2003/0153472 ("*Nagano*") and US 5,198,129 ("*Hata*") is respectfully traversed.

There is no motivation to combine the references. The base oil in *Nagano* is "an ester of a dicarboxylic acid containing 10 carbon atoms" ([0032] of *Nagano*). Further, "[a]n alcohol to be used for the formation of an ester with the aforementioned dicarboxylic acid containing 10 carbon atoms is a *monovalent aliphatic alcohol containing 6-10 carbon* atoms" ([0033] of *Nagano*, emphasis added). *Nagano* says of such esters:

An ester of a dicarboxylic acid containing 11 or more carbon atoms produces a higher torque in rotation and does not give a required performance. On the other hand, with the use of an ester of a dicarboxylic acid containing 9 or less carbon atoms, the amount of evaporation increases rapidly and it is not possible to realize a long life for spindle motors.

([0032] of *Nagano*).

Hata, on the other hand, requires "blending unsaturated aliphatic alcohols of from 16 to 24 carbon atoms...into lubricating base oils" (column 1, lines 51-52). Thus, combining Nagano and Hata would mean adding the unsaturated aliphatic alcohols having 16 to 24 carbon atoms of Hata to the dicarboxylic acids of Nagano to produce esters of a dicarboxylic acid that would not contain 10 carbon atoms.

Accordingly, one of ordinary skill in the art would not have considered modifying *Nagano* in view of *Hata*, because *Hata* discloses alcohols that would produce a base oil for *Nagano* that would be insufficient for the *Nagano* invention.

Withdrawal of the rejection is respectfully requested.

The presently claimed lubricating oils are particularly effective in degreasing efficiency, where the measurement thereof is described in the present specification:

## (b) Degreasing test

A sintered metal impregnated with the oil was subjected to extraction with n-hexane. The residual amount of the oil in the sintered metal after the extraction was measured.

See page 11, [0035] of the specification as filed. The acid phosphite esters of the present claims are particularly effective in this regard, which can be seen by comparing Example 3 (an oil having dioleyl hydrogen phosphite) and Example 6 (an oil having tri(2-ethylhexyl)phosphate). In Example 3, the residual amount of oil was found to be <u>0.0012</u> in the degreasing test; on the other hand, the same was found to be <u>0.0125</u> for Example 6. See claims 19-21.

There is no discussion of degreasing efficiency in both of *Nagano* and *Hata*.

Moreover, *Hata* discloses that zinc dithiophosphates must be present: these compounds are known to have adsorptive properties, which would result in poor degreasing efficiency. *Hata* also only exemplifies a phosphate (Example 12) that is not an acid phosphite ester.

Withdrawal of the rejection is respectfully requested.

2. The rejection of claims 11-17 under 35 USC § 103(a) in view of *Nagano*, *Hata*, and US 2002/0114980 ("*Gunsel*") is respectfully traversed for the same reasons given above— *Gunsel* does not remedy the problem of combining *Hata* and *Nagano*, discussed above.

Accordingly, the rejection is no longer tenable and should be withdrawn.

3. The rejection of claims 15-17 under 35 USC § 103(a) in view of *Nagano*, *Hata*, and US 5,275,630 ("*Dorer*") and US 5,484,542 ("*Cahoon*") is respectfully traversed for the same

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reasons given above-neither of *Dorer* and *Cahoon* remedy the problem of combining *Hata* 

and Nagano, discussed above.

Accordingly, the rejection is no longer tenable and should be withdrawn.

4. The rejection of claim 18 under 35 USC § 103(a) in view of Nagano, Hata, and US

6,586,376 ("Nakanishi") is respectfully traversed for the same reasons given above-

Nakanishi does not remedy the problem of combining Hata and Nagano, discussed above.

Accordingly, the rejection is no longer tenable and should be withdrawn.

Conclusion

Applicant respectfully submits that the above-identified application is in condition for

allowance. Notification thereof is requested.

Respectfully submitted,

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(OSMMN 07/09)

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